

REMARKS

In the final Office Action¹, the Examiner objected to claim 21; rejected claims 1-30, 33, and 34 under 35 U.S.C. § 112, first paragraph; rejected claims 1-30, 33, and 34 under 35 U.S.C. § 112, second paragraph; rejected claims 33 and 34 under 35 U.S.C. § 101; rejected claims 1-9, 16-24, and 33 under 35 U.S.C. § 103(a) as being unpatentable in view of U.S. Patent No. 6,970,127 B2 to Rakib ("*Rakib*"), U.S. Patent Application Publication No. 2002/0019827 A1 to Shiman et al. ("*Shiman*"), U.S. Patent No. 6,421,733 B1 to Tso et al. ("*Tso*"), and U.S. Patent No. 7,024,679 B1 to Sie et al. ("*Sie*"); and rejected claims 10-15, 25-30, and 34 under 35 U.S.C. § 103(a) as being unpatentable in view of *Rakib*, *Shinman*, *Tso*, *Sie*, and U.S. Patent No. 7,159,224 B2 to Sharma et al. ("*Sharma*").

By the present amendment Applicant proposes to amend claims 1, 4, 5, 13-18, 20, 21, 25, 28-30, 33, and 34. Exemplary support for the claimed features can be found in page 37, line 16 to page 38, line 6 and page 42, line 8 to page 43, line 3 of the specification. Claims 1-30, 33, and 34 remain pending.

Applicant respectfully traverses the objection to claim 21. In order to advance prosecution, however, Applicant proposes to amend claim 21 to overcome the objection. Accordingly, Applicant respectfully requests the withdrawal of the objection to claim 21.

Applicant respectfully traverses the rejection of claims 1-30, 33, and 34 under 35 U.S.C. § 112, first paragraph. Applicant asserts that "[t]here is no requirement that the

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision." See *M.P.E.P.* § 2173.05(e), 8th Ed., Rev. 6 (Sept. 2007).

The specification discloses, for example:

[A]ccording to an embodiment of the content-providing server of the present invention, the recording source content identifier is a channel list identifier as identifying information of a channel list including at least multiple channels within the receiving channels of the tuner, and the tuner control instance is configured so as **to set multiple content received by the tuner**, corresponding to multiple channels described in the channel list, **as one unit of the control content**, and executes control of the delivery content corresponding to the multiple channels described in the channel list, based on a control request corresponding to the channel list identifier received from the client. (Emphasis added, page 10, line 17 to page 11, line 3).

As noted above there is no requirement that the words in the claim must match those used in the specification, and Applicant asserts that, in view of at least the above quoted passages of the originally-filed application, one skilled in the pertinent art would have recognized that the claimed feature including the first content and the second content arranged together in a single unit of content was in possession of the inventors at the time the application was filed.

Thus, independent claims 1, 13, 16, 28, 33, and 34, and their dependent claims, fully satisfy the requirements of 35 U.S.C. § 112, and Applicant respectfully requests the Examiner to withdraw the rejection of claims 1-30, 33, and 34, under 35 U.S.C. § 112, first paragraph.

Applicant respectfully traverses the rejections of claims 1-30, 33, and 34 under 35 U.S.C. § 112, second paragraph. In order to advance prosecution, however,

Applicant proposes to amend claims 4, 5, 14-18, 20, 21, 25, 29, and 30 to overcome the rejection. Moreover, with respect to the remaining rejections under 35 U.S.C. § 112, second paragraph, Applicant respectfully submits that the Examiner is not correct, for at least the following reasons.

During examination of claims for compliance of 35 U.S.C. § 112, second paragraph, the Examiner shall focus on “whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.” M.P.E.P. § 2173.02. Further, “[a]cceptability of claim ... language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” M.P.E.P. § 2173.05(b). Therefore, if one of ordinary skill in the art would be reasonably apprised of the scope of the invention, in light of the specification, any rejection under 35 U.S.C. § 112, second paragraph, is improper. *See id.*

On page 3 of the Office Action the Examiner states that claims 1-30, 33, and 34 are indefinite because “‘multiple data as a unit of content’ is not clear.” This, however, is not correct because one of ordinary skill in the art, in view of at least page 37, line 16 to page 38, line 6 of the specification, would understand with clarity and precision that the claimed features of “arranging the first content and the second content as a unit of content” includes arranging a plurality of contents in a single unit.

On page 4 of the Office Action the Examiner states that claims 1-30, 33, and 34 are indefinite because “there appears to be a dual functionality [with respect to channel list URL] that is not plainly evident from the claim.” This, however, is not correct because one of ordinary skill in the art, in view of at least page 42, line 8 to page 43,

line 3 of the specification, would understand with clarity and precision that the claimed “channel list URL” could be used at least as a content identifier and further to switch channels. A claimed feature is not prohibited from having dual functionality, and clarification is requested if the Examiner continues to assert that claims 1-30, 33, and 34 are indefinite for this reason.

On page 4 of the Office Action the Examiner states that claims 14-30, 33, and 34 are indefinite for including the term “corresponding.” This, however, is not correct because Applicant asserts that the use of the term “corresponding” does not render claims 14-30, 33, and 34 indefinite. The use of the term “corresponding” is not prohibited, and clarification is requested if the Examiner continues to assert that claims 14-30, 33, and 34 are indefinite for this reason.

On page 5 of the Office Action the Examiner states that claim 13 is indefinite because it “lists elements of a server such as ‘tuner includes’ . . . [and] ‘an outputting device.’” This, however, is not correct because claim 13 recites “wherein **the content** received by the tuner **includes** a first content received by the tuner over a first channel and a second content received by the tuner over a second channel,” (emphasis added). Thus, one of ordinary skill in the art would understand with clarity and precision that the claimed feature recites that **the content** includes a first content and a second content, and does not recite elements of a server. Further, one of ordinary skill in the art, in view of at least page 140, lines 21-25 and Figure 39, ref. 804, would understand with clarity and precision that “an outputting device” may also be included in a client device.

Accordingly, for at least the foregoing reasons, Applicant submits that claims 1-30, 33, and 34 fulfill the requirements of 35 U.S.C. § 112 and respectfully requests

reconsideration and withdrawal of the 35 U.S.C. §112 rejection of claims 1-30, 33, and 34.

Applicant respectfully traverses the rejection of claims 33 and 34 under 35 U.S.C. § 101, first paragraph, and asserts that claims 33 and 34 as previously presented were directed to statutory subject matter. Nevertheless, in order to advance prosecution, Applicant proposes to amend claims 33 and 34 to overcome the rejection. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claims 33 and 34 under 35 U.S.C. § 101.

Applicant respectfully traverses the rejection of claims 1-9, 16-24, and 33 under 35 U.S.C. § 103(a) as being unpatentable in view of *Rakib, Shiman, Tso, and Sie*, and the rejection of claims 10-15, 25-30, and 34 under 35 U.S.C. § 103(a) as being unpatentable in view of *Rakib, Shinman, Tso, Sie, and Sharma*.

Independent claim 1 recites a content-providing server including, among other things, a “data transmission/reception unit uses the channel list URL to provide the first content and the second content to the client by establishing a connection between the server and the client . . . , wherein the provided channel list URL is used to switch between the first content and the second content by maintaining the connection and without setting a new URL to switch from the first content that is received over the first channel to the second content that is received over the second channel.”

Pages 19-20 of the Office Action concede that *Rakib* does not explicitly disclose switching between the first content and the second content based on the channel list URL, and relies on *Tso* to allegedly disclose the claimed switching. This, however, is not correct.

Tso discloses a parser 22 that includes a `GetObject(URL, InParams, & OutParams, &OutputStream, . . .)` call and a `GetScaledObject(URL, InParams, & OutParams, &OutputStream, Stage)` call. (Col. 5, lines 52-57). In *Tso*:

[t]he `GetObject()` call is used to service non-enabled client requests, and returns a non-transcoded (i.e., original) version of a specified hypertext object. In this embodiment, transcoding server 34 assumes that **each HTTP request has a unique thread** that may be blocked until the request is satisfied . . . [and] when network client 12 requests a hypertext object, HTTP remote proxy 36 uses either the `GetObject()` or `GetScaledObject()` call . . . to retrieve the hypertext object from parser 22. (Emphasis added, col. 5, line 62 to col. 6, line 28).

Thus, in *Tso* a new HTTP request with a new URL is used each time network client 12 requests a hypertext object. Even if the hypertext object of *Tso* could constitute the claimed “first content” and “second content,” which Applicant does not concede, *Tso* still does not teach or suggest the claimed “switch[ing].” This is because a new hypertext object in *Tso* is not retrieved “**by maintaining the connection and without setting a new URL** to switch from the first content that is received over the first channel to the second content that is received over the second channel,” (emphasis added) as recited in claim 1. In contrast, *Tso* discloses generating a new HTTP request with a new URL to retrieve a new hypertext object.

Shinman, Sie, and Sharma do not overcome the above-noted deficiency of *Tso* and do not teach or suggest, a “data transmission/reception unit uses the channel list URL to provide the first content and the second content to the client by establishing a connection between the server and the client . . . , wherein the provided channel list URL is used to switch between the first content and the second content by maintaining the connection and without setting a new URL to switch from the first content that is

received over the first channel to the second content that is received over the second channel," as recited in claim 1.

For at least the above reasons, the Office Action has not established a *prima facie* case of obviousness of claim 1. Thus, the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

Independent claims 13, 16, 28, 33, and 34 while of different scope than claim 1, recite features similar to those of claim 1 and are thus allowable over *Rakib, Shinman, Tso, Sie, and Sharma* for at least reasons similar to those discussed above in regard to claim 1. The remaining claims, rejected as being obvious in view of combinations of *Rakib, Shinman, Tso, Sie, and Sharma*, are also allowable at least due to their dependence from one of the independent claims.

Reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.


Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the claims in condition for allowance. In view of the foregoing, Applicant respectfully requests entry of this Amendment after final, reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Philip J. Hoffmann
Reg. No. 46,340